

- 1 -

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Challener et al.	:	Pyzocha, Michael J.
Serial No.: 10/016,792	:	Group Art Unit: 2137
Filing Date: November 2, 2001	:	
Title: TRANSMITTING A	:	IBM Corporation
BROADCAST VIA THE	:	IP Law Dept. YXSA/Bldg. 002
INTERNET WITHIN A LIMITED	:	3039 Cornwallis Road
DISTRIBUTION BASE OF	:	P.O. Box 12195
LISTENERS	:	Research Triangle Park, NC 27709

AMENDED APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I. REAL PARTY IN INTEREST

The real party in interest is International Business Machines, Inc., which is the assignee of the entire right, title and interest in the above-identified patent application.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-15, 17-18, 20-21 and 23-24 are pending in the Application. Claims 16, 19 and 22 were cancelled. Claims 1-15, 17-18, 20-21 and 23-24 stand rejected. Claims 1-15, 17-18, 20-21 and 23-24 are appealed.

IV. STATUS OF AMENDMENTS

Appellants have submitted an amendment on June 6, 2006 following receipt of the final rejection with a mailing date of April 3, 2006. The amendment (June 6, 2006) amended claims 1-2, 6-7, 11-14, 17-18, 20-21 and 23-24 to remove the terms "approximately" and "approximate" to overcome the rejections under 35 U.S.C. §112, second paragraph, thereby reducing issues for appeal. The Examiner indicated in the Advisory Action that the amendment (June 6, 2006) was entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER**Independent Claim 1:**

In one embodiment of the present invention, a method for transmitting a broadcast over the Internet by a broadcaster where the broadcast is interpreted by users located within a defined distribution area of the broadcaster comprises the step of encoding a radio broadcast into digital packets of information. Specification, page 13, lines 20-28; Figure 5, step 501. The method may further comprise encrypting the digital packets of information. Specification, page 14, lines 1-11; Figure 5, step 502. The method may further comprise transmitting the encrypted digital packets of information over the Internet. Specification, page 14, lines 12-13; Figure 5, step 503. The method may further comprise providing a decryption key to a transmitter to be broadcasted within the defined distribution area of the broadcaster. Specification, page 14, lines 14-14; Figure 5, step 504.

Independent Claim 6:

In another embodiment of the present invention, a computer program product embodied in a machine readable medium for transmitting a broadcast over the Internet by a broadcaster where the broadcast is interpreted by users located approximately within a defined distribution area of the broadcaster comprises the programming step of encoding a radio broadcast into digital packets of information.

Specification, page 10, line 20 – page 12, line 12; Specification, page 13, lines 20-28; Figure 4, elements 420, 440; Figure 5, step 501. The computer program product may further comprise encrypting the digital packets of information. Specification, page 10, line 20 – page 12, line 12; Specification, page 14, lines 1-11; Figure 4, elements 420, 440; Figure 5, step 502. The computer program product may further comprise transmitting the encrypted digital packets of information over the Internet. Specification, page 10, line 20 – page 12, line 12; Specification, page 14, lines 12-13; Figure 4, elements 420, 440; Figure 5, step 503. The computer program product may further comprise providing a decryption key to a transmitter to be broadcasted within the defined distribution area of the broadcaster. Specification, page 10, line 20 – page 12, line 12; Specification, page 14, lines 14-14; Figure 4, elements 420, 440; Figure 5, step 504.

Independent Claim 11:

In another embodiment of the present invention, a system, comprises a server broadcaster configured to transmit a broadcast over the Internet, where the server broadcaster comprises a processor and a memory unit coupled to the processor, where the memory unit is operable for storing a computer program operable for transmitting a broadcast over the Internet, where the broadcast is interpreted by users located within a defined distribution area of the server broadcaster, where the computer program is operable for performing the programming step of encoding a radio broadcast into digital packets of information. Specification, page 7, lines 3-20; Specification, page 10, line 20 – page 12, line 12; Specification, page 13, lines 20-28; Figure 1, element 110; Figure 4, elements 410, 414, 420, 440; Figure 5, step 501. The computer program is further operable for performing the programming step of encrypting the digital packets of information. Specification, page 10, line 20 – page 12, line 12; Specification, page 14, lines 1-11; Figure 4, elements 420, 440; Figure 5, step 502. The computer program is further operable for performing the programming step of transmitting the encrypted digital packets of information over the Internet.

Specification, page 10, line 20 – page 12, line 12; Specification, page 14, lines 12-13; Figure 4, elements 420, 440; Figure 5, step 503. The computer program is further operable for performing the programming step of providing a decryption key to a transmitter to be broadcasted via radio frequencies within the defined distribution area of the server broadcaster. Specification, page 10, line 20 – page 12, line 12; Specification, page 14, lines 14-14; Figure 4, elements 420, 440; Figure 5, step 504.

Independent Claim 17:

In another embodiment of the present invention, a method for transmitting a broadcast over the Internet within a defined distribution area comprises the step of receiving a request to transmit the broadcast from a requester. Specification, page 16, line 25 – page 17, line 2; Figure 6, step 601. The method may further comprise determining a physical location of the requester. Specification, page 17, lines 3-4; Figure 6, step 602. The method may further comprise transmitting the broadcast over the Internet to the requester if the requester is physically located within the defined distribution area. Specification, page 17, line 24 – page 18, line 2; Figure 6, step 604. Further, the step of determining the physical location of the requester comprises the step of capturing an Internet Protocol address of the requester. Specification, page 17, lines 5-17; Figure 7, step 701. The step of determining the physical location of the requester further comprises converting the captured Internet Protocol address of the requester into a computer name. Specification, page 17, lines 5-17; Figure 7, step 702. The step of determining the physical location of the requester further comprises performing a trace of the request. Specification, page 17, lines 5-17; Figure 7, step 703.

Independent Claim 20:

In another embodiment of the present invention, a computer program product embodied in a machine readable medium for transmitting a broadcast over the Internet within a defined distribution area comprises the programming step of

receiving a request to transmit the broadcast from a requester. Specification, page 10, line 20 – page 12, line 12; Specification, page 16, line 25 – page 17; Figure 4, elements 420, 440; Figure 6, step 601. The computer program product may further comprise determining a physical location of the requester. Specification, page 10, line 20 – page 12, line 12; Specification, page 17, lines 3-4; Figure 4, elements 420, 440; Figure 6, step 602. The computer program product may further comprise transmitting the broadcast over the Internet to the requester if the requester is physically located within the defined distribution area. Specification, page 10, line 20 – page 12, line 12; Specification, page 17, line 24 – page 18, line 2; Figure 4, elements 420, 440; Figure 6, step 604. Further, the programming step of determining the physical location of the requester comprises the programming step of capturing an Internet Protocol address of the requester. Specification, page 10, line 20 – page 12, line 12; Specification, page 17, lines 5-17; Figure 4, elements 420, 440; Figure 7, step 701. The programming step of determining the physical location of the requester further comprises converting the captured Internet Protocol address of the requester into a computer name. Specification, page 10, line 20 – page 12, line 12; Specification, page 17, lines 5-17; Figure 4, elements 420, 440; Figure 7, step 702. The programming step of determining the physical location of the requester further comprises performing a trace of the request. Specification, page 10, line 20 – page 12, line 12; Specification, page 17, lines 5-17; Figure 4, elements 420, 440; Figure 7, step 703.

Independent Claim 23:

In another embodiment of the present invention, a system comprises a processor. Figure 4, element 410. The system may further comprise a memory unit coupled to the processor, where the memory unit is operable for storing a computer program operable for transmitting a broadcast over the Internet within a defined distribution area, where the computer program is operable for performing the programming step of receiving a request to transmit the broadcast from a requester.

Specification, page 10, line 20 – page 12, line 12; Specification, page 16, line 25 – page 17; Figure 4, elements 414, 420, 440; Figure 6, step 601. The computer program is further operable for performing the programming step of determining a physical location of the requester. Specification, page 10, line 20 – page 12, line 12; Specification, page 17, lines 3-4; Figure 4, elements 420, 440; Figure 6, step 602. The computer program is further operable for performing the programming step of transmitting the broadcast over the Internet to the requester if the requester is physically located within the defined distribution area. Specification, page 10, line 20 – page 12, line 12; Specification, page 17, line 24 – page 18, line 2; Figure 4, elements 420, 440; Figure 6, step 604. Further, the programming step of determining the physical location of the requester comprises the programming step of capturing an Internet Protocol address of the requester. Specification, page 10, line 20 – page 12, line 12; Specification, page 17, lines 5-17; Figure 4, elements 420, 440; Figure 7, step 701. The programming step of determining the physical location of the requester further comprises converting the captured Internet Protocol address of the requester into a computer name. Specification, page 10, line 20 – page 12, line 12; Specification, page 17, lines 5-17; Figure 4, elements 420, 440; Figure 7, step 702. The programming step of determining the physical location of the requester further comprises performing a trace of the request. Specification, page 10, line 20 – page 12, line 12; Specification, page 17, lines 5-17; Figure 4, elements 420, 440; Figure 7, step 703.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Claims 1-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pezzillo et al. (U.S. Patent No. 6,434,621) (hereinafter "Pezzillo") in view of Teare et al. (U.S. Patent No. 5,243,652) (hereinafter "Teare").

B. Claims 17-18, 20-21 and 23-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Franken et al. (U.S. Publication No. 2003/0097654)

(hereinafter "Franken") in view of Schlossberg et al. (U.S. Publication No. 2002/0066034) (hereinafter "Schlossberg").

VII. ARGUMENT

A. Claim 1-15 are improperly rejected under 35 U.S.C. §103(a) as being unpatentable over Pezzillo in view of Teare.

The Examiner rejects claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over Pezzillo in view of Teare. Office Action (4/14/2006), page 3. Appellants respectfully traverse these rejections for at least the reasons stated below.

1. Pezzillo and Teare, taken singly or in combination, do not teach or suggest the following claim limitations.

a. Claims 1, 6 and 11 are patentable over Pezzillo in view of Teare.

Regarding claims 1, 6 and 11, Appellants respectfully assert that Pezzillo and Teare, taken singly or in combination, do not teach or suggest "providing a decryption key to a transmitter to be broadcasted within said defined distribution area of said broadcaster." The Examiner cites Figure 1 and column 2, lines 11-63 of Teare as teaching the above-cited claim limitation. Office Action (4/14/2006), page 3. Appellants respectfully traverse and assert that Teare instead teaches a mobile unit (e.g., aircraft) that stores encrypted signals. Column 2, lines 11-12. Teare further teaches that a central facility 12 which may authorize the viewing of the encrypted video signal on an airplane if the airplane is over 25,000 ft. altitude and over a pre-designated area. Column 2, lines 40-42. There is no language in the cited passage that teaches providing a decryption key to a transmitter to be broadcasted within a defined distribution area of a broadcaster. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1, 6 and 11, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

In response to Appellants' above argument, the Examiner states:

[A]s seen in Figure 1 the central facility 12 has a storage of decryption keys which are provided to a transmitter which broadcasts them over the air to the remote node 11. This remote node has to be within a specific geographic location (see column 2 lines 36-49). Office Action (4/14/2006), pages 8-9.

Appellants respectfully traverse. Appellants agree that central facility 12 stores decryption keys, where a code decryption key is transmitted to remote node 11 to decode the encrypted signal. Column 2, lines 46-49 of Teare. However, the decryption key is not broadcasted within a defined distribution area of the broadcaster. There is no language in Teare that the decryption key is transmitted to the remote node 11 with a limitation as to the area of its transmission. That is, there is no language in Teare that the decryption key is broadcasted within a designated area of the central facility 12. Instead, Teare teaches that the central facility 12 may only authorize viewing of the encrypted video signal on an airplane if the plane is over 25,000 ft. altitude and over a pre-designated area. Column 2, lines 39-42. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1, 6 and 11, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Furthermore, regarding claims 1, 6 and 11, Appellants respectfully assert that Pezzillo and Teare, taken singly or in combination, do not teach or suggest "encrypting said digital packets of information." The Examiner cites column 2, lines 11-63 of Teare as teaching the above-cited claim limitation. Office Action (4/14/2006), page 3. Appellants respectfully traverse and assert that Teare instead teaches a mobile unit (e.g., aircraft) that stores encrypted signals. Column 2, lines 11-12. Teare further teaches that a central facility 12 which may authorize the viewing of the encrypted video signal on an airplane if the airplane is over 25,000 ft. altitude and over a pre-designated area. Column 2, lines 40-42. There is no language in the cited passage that teaches encrypting digital packets of information. Instead, Teare

teaches the storage and transfer of encrypted signals. Teare does not specifically teach in the cited passage the actual encryption of the signals. Neither is there any language in the cited passage that teaches encrypting digital packets of information in which a radio broadcast was encoded into the digital packets of information. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1, 6 and 11, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

The Examiner, in response to Appellants' above argument, asserts that the step of encrypting the content must have inherently occurred at some point in time. Office Action (4/14/2006), page 8. While it is true, that at some point in time, encrypted content must have been encrypted, there is no language in the cited passage that suggests that Teare would encrypt digital packets of information. Instead, the encrypted signals are already located on remote node 11. Column 2, lines 11-12. The encrypted signals become decoded with a decryption key from central facility 12 if the position of the airplane is over 25,000 ft. altitude. Column 2, lines 40-49. Hence, there is no need for Teare to perform any encryption as the signals are already encrypted. Hence, Teare does not teach encrypting digital packets of information as asserted by the Examiner. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1, 6 and 11, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

b. Claims 2-5 are patentable over Pezzillo in view of Teare for at least the reasons that claim 1 is patentable over Pezzillo in view of Teare.

Claims 2-5 each recite combinations of features of independent claim 1, and hence claims 2-5 are patentable over Pezzillo in view of Teare for at least the reasons that claim 1 is patentable over Pezzillo in view of Teare.

c. Claims 7-10 are patentable over Pezzillo in view of Teare for at least the reasons that claim 6 is patentable over Pezzillo in view of Teare.

Claims 7-10 each recite combinations of features of independent claim 6, and hence claims 7-10 are patentable over Pezzillo in view of Teare for at least the reasons that claim 6 is patentable over Pezzillo in view of Teare.

d. Claims 12-15 are patentable over Pezzillo in view of Teare for at least the reasons that claim 11 is patentable over Pezzillo in view of Teare.

Claims 12-15 each recite combinations of features of independent claim 11, and hence claims 12-15 are patentable over Pezzillo in view of Teare for at least the reasons that claim 11 is patentable over Pezzillo in view of Teare.

e. Claims 2, 7 and 12 are patentable over Pezzillo in view of Teare.

Regarding claims 2, 7 and 12, Appellants respectfully assert that Pezzillo and Teare, taken singly or in combination, do not teach or suggest "receiving said decryption key by one or more users of computer systems located within said defined distribution area of said broadcaster." The Examiner cites column 2, lines 11-63 of Teare as teaching the above-cited claim limitation. Office Action (4/14/2006), page 4. Appellants respectfully traverse. As stated above, Teare instead teaches a mobile unit (e.g., aircraft) that stores encrypted signals. Column 2, lines 11-12. Teare further teaches that a central facility 12 which may authorize the viewing of the encrypted video signal on an airplane if the airplane is over 25,000 ft. altitude and over a pre-designated area. Column 2, lines 40-42. There is no language in the cited passage that teaches receiving a decryption key. Neither is there any language in the cited passage that teaches receiving a decryption key by one or more users of computer systems. Neither is there any language in the cited passage that teaches receiving a decryption key by one or more users of computer systems located within a defined distribution area of a broadcaster. Therefore, the Examiner has not presented a *prima*

facie case of obviousness in rejecting claims 2, 7 and 12, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

The Examiner, in response to Appellants' above arguments, points out that Teare (column 2, lines 46-49) teaches that the authorization would be accomplished by transmission of a code decryption key from the central facility 12 to a remote node 11, where the encrypted signal would be decoded with the key. Office Action (4/14/2006), page 9. However, there is no language in the cited passage that teaches receiving a decryption key by one or more users of computer systems. Neither is there any language in the cited passage that teaches receiving a decryption key by one or more users of computer systems within a defined distribution area of the broadcaster. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 2, 7 and 12, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

f. Claims 5, 10 and 15 are patentable over Pezzillo in view of Teare.

Regarding claims 5, 10 and 15, Appellants respectfully assert that Pezzillo and Teare, taken singly or in combination, do not teach or suggest "wherein said decryption key is transmitted via electromagnetic waves within said defined distribution area of said broadcaster" as recited in claim 5 and similarly in claims 10 and 15. The Examiner cites column 2, lines 11-63 of Teare as teaching the above-cited claim limitation. Office Action (4/14/2006), page 5. Appellants respectfully traverse. As stated above, Teare instead teaches a mobile unit (e.g., aircraft) that stores encrypted signals. Column 2, lines 11-12. Teare further teaches that a central facility 12 which may authorize the viewing of the encrypted video signal on an airplane if the airplane is over 25,000 ft. altitude and over a pre-designated area. Column 2, lines 40-42. Teare additionally teaches that the authorization would be

accomplished by transmission of a code decryption key from the central facility 12 to remote node 11, where the encrypted signal would be decoded with the key. Column 2, lines 46-49. There is no language in the cited passage that teaches that the decryption key is transmitted within a defined distribution area of a broadcaster. Hence, Teare does not teach transmitting a decryption key via electromagnetic waves within a defined distribution area of a broadcaster. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 5, 10 and 15, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

2. The Examiner's motivation in modifying Pezzillo to incorporate the limitations of claims 1, 6 and 11 is insufficient to establish a *prima facie* case of obviousness in rejecting claims 1-15.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembicza*k, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an

implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Pezzillo does not teach encrypting the digital packets of information, as recited in claim 1 and similarly in claims 6 and 11. Office Action (4/14/2006), page 3. The Examiner further admits that Pezzillo does not teach transmitting the encrypted digital packets of information over the Internet, as recited in claim 1 and similarly in claims 6 and 11. Office Action (4/14/2006), pages 7-8. The Examiner further admits that Pezzillo does not teach providing a decryption key to a transmitter to be broadcasted within the defined distribution area of the broadcast, as recited in claim 1 and similarly in claims 6 and 11. Office Action (4/14/2006), page 3. The Examiner's motivation for modifying Pezzillo with Teare to include the above-cited claim limitations is "to provide location-sensitive control over remote or mobile systems in a secure manner, without requiring secure facilities for the remote or mobile node (see column 1, lines 34-37)." Office Action (4/14/2006), page 4. The Examiner's motivation is insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

The Examiner's motivation does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Pezzillo to include the above-cited missing claim limitations from claims 1, 6 and 11. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-15. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Pezzillo address the problem of overriding an Internet station's program schedule and forcing a show or live event to occur at a specific time in the future as well as an automating DMCA/SRPC compliance and reporting method for Internet broadcasting and automatically controlling advertising inserts. Column 2, line 64 – column 3, line 7. The Examiner has not provided any reasons as to why one skilled

in the art would modify Pezzillo, which overcomes the above-mentioned problems by enabling Internet or Intranet broadcasting that offers audio automation and webcast automation (Abstract), to: (1) encrypt the digital packets of information; (2) transmit the encrypted digital packets of information over the Internet; and (3) provide a decryption key to a transmitter to be broadcasted within the defined distribution area of the broadcast (Examiner admits that Pezzillo does not teach these limitations). The Examiner's motivation ("provide location-sensitive control over remote or mobile systems (e.g., aircraft) in a secure manner, without requiring secure facilities for the remote or mobile node") does not provide such reasoning. The Examiner has not provided any rationale connection between providing location-sensitive control over remote or mobile systems (e.g., aircraft) in a secure manner, without requiring secure facilities for the remote or mobile node (Examiner's motivation) to (1) encrypting the digital packets of information; (2) transmitting the encrypted digital packets of information over the Internet; and (3) providing a decryption key to a transmitter to be broadcasted within the defined distribution area of the broadcast. Hence, the Examiner's motivation does not provide reasons the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Pezzillo to include the missing claim limitations of claims 1, 6 and 11. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-15. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

3. Examiner has not provided a motivation for modifying Pezzillo to include the limitations of claims 2-3, 5, 7-8, 10, 12-13 and 15.

In order to establish a *prima facie* case of obviousness, the Examiner must submit some suggestion or motivation to modify the reference to combine reference teachings. M.P.E.P. §2143. The Examiner admits that Pezzillo does not teach the limitations of claims 2-3, 5, 7-8, 10, 12-13 and 15. Office Action (4/14/2006), pages 4-5. The Examiner modifies Pezzillo with Teare to include the missing claim limitations of claims 2-3, 5, 7-8, 10, 12-13 and 15. Office Action (4/14/2006), pages

4-5. However, the Examiner fails to present any motivation for modifying Pezzillo to include the missing claim limitations of claims 2-3, 5, 7-8, 10, 12-13 and 15. Hence, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 2-3, 5, 7-8, 10, 12-13 and 15. M.P.E.P. §2143.

In response to Appellants' above arguments, the Examiner appears to assert that the Examiner does not have to provide motivation for modifying Pezzillo to include the missing claim limitations of dependent claims. The Examiner states:

Once the references have been combined they have been considered to be a new system with the combined teachings of both references. Office Action (4/14/2006), page 12.

Appellants respectfully traverse. The Examiner is required to provide motivation for modifying a reference to include the missing claim limitation of the claimed invention. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998); M.P.E.P. §2143. There is no language in the M.P.E.P. that states that the Examiner's burden is only to provide motivation with respect to missing claim limitations from the independent claims. Whether the missing claim limitation is in an independent claim or in a dependent claim, the Examiner is still required to provide such a motivation. Since the Examiner has not provided a motivation for modifying Pezzillo to include the missing claim limitations of dependent claims 2-3, 5, 7-8, 10, 12-13 and 15, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 2-3, 5, 7-8, 10, 12-13 and 15. M.P.E.P. §2143.

Further, if the Examiner is asserting that the motivation for modifying Pezzillo to: (1) encrypt the digital packets of information; (2) transmit the encrypted digital packets of information over the Internet; and (3) provide a decryption key to a transmitter to be broadcasted within the defined distribution area of the broadcast, is the same motivation for modifying Pezzillo to include the limitations of claims 2-3, 5, 7-8, 10, 12-13 and 15, then Appellants respectfully traverse.

The Examiner's motivation ("provide location-sensitive control over remote or mobile systems (e.g., aircraft) in a secure manner, without requiring secure facilities for the remote or mobile node") for modifying Pezzillo to include the limitations of claim 1 does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Pezzillo to include the above-cited missing claim limitations from claims 2-3, 5, 7-8, 10, 12-13 and 15. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 2-3, 5, 7-8, 10, 12-13 and 15. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Pezzillo address the problem of overriding an Internet station's program schedule and forcing a show or live event to occur at a specific time in the future as well as an automating DMCA/SRPC compliance and reporting method for Internet broadcasting and automatically controlling advertising inserts. Column 2, line 64 – column 3, line 7. The Examiner has not provided any reasons as to why one skilled in the art would modify Pezzillo, which overcomes the above-mentioned problems by enabling Internet or Intranet broadcasting that offers audio automation and webcast automation (Abstract), to: (1) receive a decryption key by one or more computer systems located within a defined distribution area of a broadcaster, as recited in claims 2, 7 and 12; (2) decrypt the encrypted digital packets of information using the decryption key, as recited in claims 3, 8 and 13; (3) transmit the decryption key via electromagnetic waves within the defined distribution area of the broadcaster, as recited in claims 5, 10 and 15 (Examiner admits that Pezzillo does not teach these limitations). The Examiner's motivation ("provide location-sensitive control over remote or mobile systems (e.g., aircraft) in a secure manner, without requiring secure facilities for the remote or mobile node") does not provide such reasoning. Hence, the Examiner's motivation does not provide reasons the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Pezzillo to include the missing claim limitations of claims 2-3, 5, 7-8, 10, 12-13 and 15. Accordingly, the Examiner has not presented a *prima*

facie case of obviousness for rejecting claims 2-3, 5, 7-8, 10, 12-13 and 15. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

4. Examiner Relies on a Reference Under 35 U.S.C. §103 that is not Analogous Prior Art.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. M.P.E.P. §2143.01. In order to rely on a reference as a basis for rejection under 35 U.S.C. §103(a), the reference must either be in the field of Appellants' endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). The Examiner cites the Pezzillo and Teare references in his rejection of claims 1-15 under 35 U.S.C. §103(a). The Teare reference addresses the problem of transmitting geo-graphical information in a secured manner over remote or mobile systems without requiring secure facilities for the remote or mobile node. Column 1, lines 23-37. The Teare reference does not address the problem of providing information to a small distribution base as asserted by the Examiner. Office Action (4/14/2006), page 11. Appellants, on the other hand, address the problem of enabling broadcasters to transmit information over the Internet to a smaller distribution base of listeners thereby lessening the amount of copyright royalty fees the broadcaster may be required to pay. Specification, page 2, lines 10-13. Hence, the Teare reference is not in the same field as Appellants' endeavor and is not reasonably pertinent to solving the problem of enabling broadcasters to transmit information over the Internet to a smaller distribution base of listeners thereby lessening the amount of copyright royalty fees the broadcaster may be required to pay. As a result, the Teare reference is not an analogous prior art and the Examiner has not established a *prima facie* case of obviousness in rejecting claims 1-15. M.P.E.P. §2141.01; 2143.01.

5. Examiner's motivation for modifying Pezzillo and Teare to include the limitation of claims 4, 9 and 14 is insufficient.

Regarding claims 4, 9 and 14, Appellants respectfully assert that Pezzillo and Teare, taken singly or in combination, do not teach or suggest "reproducing said decrypted digital broadcast by an audio transducer." The Examiner takes Official Notice that it would have been obvious to a person of ordinary skill in the art to use an audio transducer to reproduce the digital broadcast. Office Action (4/14/2006), pages 4-5. The Examiner's motivation for modifying Pezzillo and Teare to use an audio transducer to reproduce the digital broadcast is to allow the receiver to hear the digital broadcast. Office Action (4/14/2006), page 5. Appellants respectfully traverse.

In order to establish a *prima facie* case of obviousness the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 1994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The Examiner admits that Pezzillo and Teare, taken in combination, do not teach reproducing a decrypted digital broadcast by an audio transducer, as recited in claim 4 and similarly in claims 9 and 14 Office Action (4/14/2006), pages 4-5. As stated above, the Examiner's motivation for modifying Pezzillo and Teare to include the above-cited claim limitation is "to allow the receiver to hear the digital broadcast." However, the Examiner has not provided any evidence that his motivation comes from any of the sources listed above. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 4, 9 and 14. *Id.*

Further, as stated above, in order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner's motivation does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Pezzillo to include the above-cited missing claim limitation from claims 4, 9 and 14. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 4, 9 and 14. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

As stated above, Pezzillo address the problem of overriding an Internet station's program schedule and forcing a show or live event to occur at a specific time in the future as well as an automating DMCA/SRPC compliance and reporting method for Internet broadcasting and automatically controlling advertising inserts. Column 2, line 64 – column 3, line 7. The Examiner has not provided any reasons as to why one skilled in the art would modify Pezzillo, which overcomes the above-mentioned problems by enabling Internet or Intranet broadcasting that offers audio automation and webcast automation (Abstract), to reproduce a decrypted digital broadcast by an audio transducer (Examiner admits that Pezzillo does not teach this limitation). The Examiner's motivation ("to allow the receiver to hear the digital broadcast") does not provide such reasoning. Hence, the Examiner's motivation does not provide reasons the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Pezzillo to include the missing claim limitations of claims 4, 9 and 14. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 4, 9 and 14. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

B. Claims 17-18, 20-21 and 23-24 are improperly rejected under 35 U.S.C. §103(a) as being unpatentable over Franken in view of Schlossberg.

The Examiner has rejected claims 17-18, 20-21 and 23-24 under 35 U.S.C. §103(a) as being unpatentable over Franken in view of Schlossberg. Office Action (4/14/2006), page 5. Appellants respectfully traverse these rejections for at least the reasons stated below.

As stated above, in order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembicza*k, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Franken does not teach capturing an Internet Protocol address of the requester; converting the captured Internet Protocol of the requester into a computer name; and performing a trace of the request, as recited in claims 17, 20 and 23. Office Action (4/14/2006), pages 5-6. The Examiner's motivation for modifying Franken with Schlossberg to include the above-cited claim limitations is "to determine the physical location of a device on the Internet (see paragraph 54)." Office Action (4/14/2006), page 6. The Examiner's motivation is insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

The Examiner's motivation does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Franken to include the above-cited missing claim limitation from claims 17, 20 and 23. According, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 17-18, 20-21 and 23-24. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

As stated above, the Examiner cites [0054] of Schlossberg as the source of the Examiner's motivation. Schlossberg teaches that the reconnaissance unit (element 117) notifies the owner of the security system and generates a detailed report to the network security personnel with information, such as the MAC/IP address the attacker is using, the attacker's machine DNS name, the attacker's physical location, and other pertinent information. [0054]. Hence, [0054] of Schlossberg teaches using a reconnaissance unit to identify attackers such as obtaining the IP address the attacker is using. Thus, the Examiner's statement that [0054] of Schlossberg teaches the motivation for determining the physical location of a device on the Internet is not complete. [0054] of Schlossberg teaches the motivation of using a reconnaissance unit to identify attackers such as obtaining the IP address the attacker is using.

Franken addresses the problem of delivering television and radio programming via the Internet while taking into consideration the well-established territorial restrictions. [0005]-[0007]. The Examiner has not provided any reasons as to why one skilled in the art would modify Franken, which overcomes the above-mentioned problem by utilizing an authorization scheme based upon numerous criteria, including a signal strength calculator, a distance from a point calculator, and a GIS boundary computer (Abstract), to capture an Internet Protocol address of the requester; to convert the captured Internet Protocol of the requester into a computer name; and to perform a trace of the request (Examiner admits that Franken does not teach these limitations). As stated above, the Examiner's source of motivation ([0054] of Schlossberg) teaches using a reconnaissance unit to identify attackers such

as obtaining the IP address the attacker is using. This does not provide reasons as to why one skilled in the art would modify Franken, whose purpose is to utilize an authorization scheme based upon numerous criteria, including a signal strength calculator, a distance from a point calculator, and a GIS boundary computer, to capture an Internet Protocol address of the requester; to convert the captured Internet Protocol of the requester into a computer name; and to perform a trace of the request. Further, the Examiner has not provided any rationale connection between using a reconnaissance unit to identify attackers such as obtaining the IP address the attacker is using (Examiner's motivation) and capturing an Internet Protocol address of the requester; converting the captured Internet Protocol of the requester into a computer name; and performing a trace of the request (missing claim limitations). Hence, the Examiner's motivation does not provide reasons the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Franken to include the missing claim limitations of claims 17, 20 and 23. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 17-18, 20-21 and 23-24. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

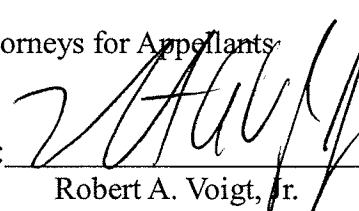
VIII. CONCLUSION

For the reasons noted above, the rejections of claims 1-15, 17-18, 20-21 and 23-24 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 1-15, 17-18, 20-21 and 23-24.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Appellants

By: 
Robert A. Voigt, Jr.
Reg. No. 47,159

P.O. Box 50784
Dallas, Texas 75201
(512) 370-2832

CLAIMS APPENDIX

1. A method for transmitting a broadcast over the Internet by a broadcaster where the broadcast is interpreted by users located within a defined distribution area of the broadcaster, comprising the steps of:
 - encoding a radio broadcast into digital packets of information;
 - encrypting said digital packets of information;
 - transmitting said encrypted digital packets of information over the Internet;
 - and
 - providing a decryption key to a transmitter to be broadcasted within said defined distribution area of said broadcaster.
2. The method as recited in claim 1 further comprising the step of:
 - receiving said decryption key by one or more users of computer systems located within said defined distribution area of said broadcaster.
3. The method as recited in claim 2 further comprising the step of:
 - decrypting said encrypted digital packets of information using said decryption key.
4. The method as recited in claim 3 further comprising the step of:
 - reproducing said decrypted digital broadcast by an audio transducer.
5. The method as recited in claim 1, wherein said decryption key is transmitted via electromagnetic waves within said defined distribution area of said broadcaster.
6. A computer program product embodied in a machine readable medium for transmitting a broadcast over the Internet by a broadcaster where the broadcast is interpreted by users located approximately within a defined distribution area of the broadcaster comprising the programming steps of:

encoding a radio broadcast into digital packets of information;
encrypting said digital packets of information;
transmitting said encrypted digital packets of information over the Internet;
and

providing a decryption key to a transmitter to be broadcasted within said defined distribution area of said broadcaster.

7. The computer program product as recited in claim 6 further comprises the programming step of:

receiving said decryption key by one or more users of computer systems located within said defined distribution area of said broadcaster.

8. The computer program product as recited in claim 7 further comprises the programming step of:

decrypting said encrypted digital packets of information using said decryption key.

9. The computer program product as recited in claim 8 further comprises the programming step of:

reproducing said decrypted digital broadcast by an audio transducer.

10. The computer program product as recited in claim 6, wherein said decryption key is transmitted via electromagnetic waves within said defined distribution area of said broadcaster.

11. A system, comprising:

a server broadcaster configured to transmit a broadcast over the Internet, wherein said server broadcaster comprises:

a processor; and

a memory unit coupled to said processor, wherein said memory unit is operable for storing a computer program operable for transmitting a broadcast over the Internet, wherein said broadcast is interpreted by users located within a defined distribution area of said server broadcaster, wherein the computer program is operable for performing the following programming steps:

encoding a radio broadcast into digital packets of information;
style="padding-left: 40px;">encrypting said digital packets of information; and
style="padding-left: 40px;">transmitting said encrypted digital packets of information over the Internet; and

providing a decryption key to a transmitter to be broadcasted via radio frequencies within said defined distribution area of said server broadcaster.

12. The system as recited in claim 11 further comprising:

one or more computer systems coupled to said server broadcaster, wherein one or more of said one or more computer systems are located within said defined distribution area of said server broadcaster, wherein each of said one or more computer systems located within said defined distribution area of said server broadcaster comprises:

a processor; and

a memory unit coupled to said processor, wherein said memory unit is operable for storing a computer program, wherein the computer program is operable for performing the following programming step:

receiving said decryption key.

13. The system as recited in claim 12, wherein the computer program in each of said one or more computer systems located within said defined distribution area of said server broadcaster is further operable for performing the following programming step:

decrypting said encrypted digital packets of information using said decryption

key.

14. The system as recited in claim 13, wherein the computer program in each of said one or more computer systems located within said defined distribution area of said server broadcaster is further operable for performing the following programming step:

reproducing said decrypted digital broadcast by an audio transducer.

15. The system as recited in claim 11, wherein said decryption key is transmitted via electromagnetic waves within said defined distribution area of said server broadcaster.

17. A method for transmitting a broadcast over the Internet within a defined distribution area, comprising the steps of:

receiving a request to transmit said broadcast from a requester;

determining a physical location of said requester; and

transmitting said broadcast over the Internet to said requester if said requester is physically located within said defined distribution area;

wherein said step of determining said physical location of said requester comprises the steps of:

capturing an Internet Protocol address of said requester;

converting said captured Internet Protocol address of said requester into a computer name; and

performing a trace of said request.

18. The method as recited in claim 17, wherein said broadcast is not transmitted over the Internet to said requester if said requester is physically located outside said defined distribution area.

20. A computer program product embodied in a machine readable medium for transmitting a broadcast over the Internet within a defined distribution area comprising the programming steps of:

receiving a request to transmit said broadcast from a requester;

determining a physical location of said requester; and

transmitting said broadcast over the Internet to said requester if said requester is physically located within said defined distribution area;

wherein said programming step of determining said physical location of said requester comprises the programming steps of:

capturing an Internet Protocol address of said requester;

converting said captured Internet Protocol address of said requester into a computer name; and

performing a trace of said request.

21. The computer program product as recited in claim 20, wherein said broadcast is not transmitted over the Internet to said requester if said requester is physically located outside said defined distribution area.

23. A system, comprising:

a processor; and

a memory unit coupled to said processor, wherein said memory unit is operable for storing a computer program operable for transmitting a broadcast over the Internet within a defined distribution area, wherein the computer program is operable for performing the following programming steps:

receiving a request to transmit said broadcast from a requester;

determining a physical location of said requester; and

transmitting said broadcast over the Internet to said requester if said requester is physically located within said defined distribution area;

wherein said programming step of determining said physical location of said

requester comprises the programming steps of:

capturing an Internet Protocol address of said requester;

converting said captured Internet Protocol address of said requester into a computer name; and

performing a trace of said request.

24. The system as recited in claim 23, wherein said broadcast is not transmitted over the Internet to said requester if said requester is physically located outside said defined distribution area.

EVIDENCE APPENDIX

No evidence was submitted pursuant to §§1.130, 1.131, or 1.132 of 37 C.F.R. or of any other evidence entered by the Examiner and relied upon by Appellants in the Appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings to the current proceeding.

Austin_1 325104v.1